

REMARKS/ARGUMENTS

Upon entry of the above amendment, claims 19-21 and 23-25 will have been amended and submitted for consideration by the Examiner. Thus, claims 19-27 remain pending in the present application. Applicant respectfully requests reconsideration of the outstanding rejections of the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Official Action provided, and for conducting of an interview by phone on December 15, 2004.

Applicant notes with appreciation the Examiner's acknowledgment of Applicant's Information Disclosure Statement filed in the present application on June 8, 2004 by the return of the initialed and signed PTO-1449 Form, and for consideration of the documents cited in the Information Disclosure Statement.

However, Applicant also notes that Applicant has filed an Information Disclosure Statement in the present application on September 29, 1999. Accordingly, Applicant respectfully requests that the Examiner send a copy of the signed PTO-1449 Form attached to the Information Disclosure Statement to Applicant.

Turning to the merits of the action, the Examiner has rejected claims 19, 20, 22, 24 and 25 under 35U.S.C § 103(a), as being unpatentable over MURPHY (U.S. Patent No. 6,028,679) in view of European Patent Application (EP 0 835 011 A1). The Examiner also rejected claims 21 and 23 under 35 U.S.C § 103(a), as being unpatentable over MURPHY (U.S. Patent No. 6,028,679) in view of European Patent Application (EP 0 835 011 A1) and further in view of JP Publication (09-231121). The Examiner further rejected claim 19 under 35 U.S.C § 103(a) as being unpatentable over SAFAI et al. (U.S. Patent No. 6,167,469) in

view of European Patent Application (EP 0 835 011 A1). The Examiner further rejected claim 19 under 35 U.S.C § 103 (a) as being unpatentable over JP Publication (09-231121) in view of European Patent Application (EP 0 835 011 A1).

As noted above, Applicant has submitted the amended claims 19-21, and 23-25. Applicant respectfully traverses the above rejections based on the pending claims 19-27 and will discuss the rejection with respect to the pending claims in the present application as will be set forth herein below. The newly amended claims merely clarify the subject matter, but do not narrow the scope of the claims.

Applicant's invention, as disclosed, relates to an image data transmission system wherein a file converter within a transmitting apparatus converts image data into a predetermined plurality of file formats such that the data of each file format includes all of the image data. A transmitter determines the server corresponding to a recipient when an e-mail address of the recipient is input and transmits, to the server, the data in each of the plurality of file formats. Thus, the recipient can select from the server, the file format appropriate to it and extract the image data of the selected file format from the server.

Applicant's claims relate to an image data transmitting apparatus that has a memory in which an e-mail address of a recipient and an address of a server corresponding to the e-mail address of the recipient are stored, and a file converter that converts image data into a predetermined plurality of file formats, the data of each file format including all of the image data. The image transmitting apparatus includes a transmitter that determines the server corresponding to the recipient when the e-mail address of the recipient is input, transmits to the server the data in each of the predetermined plurality of file formats and transmits to the recipient, by e-mail, the address of the server in which the data in the predetermined plurality

P18153.A15

of file formats corresponding to the image data is stored. Thus, Applicant's transmitting apparatus includes the file converter and the transmitter which transmits the plurality of data files to the server and the address of the appropriate server to the recipient. Thereby, the recipient accesses the server by using the address and selects, from the server, image data that is stored in a file format corresponding to the capability of the recipient.

Applicant's invention is also directed to an image receiving apparatus connected to an image transmitting apparatus through a network including at least one server. The server is configured to store image data to be received in a predetermined plurality of file formats, data of each file format including all of the of the image data. The image receiving apparatus receives an e-mail of an address of a server in which the image data to be received is stored, accesses the server by using said address to select image data that is stored in a file format corresponding to the capability of the image receiving apparatus and extracts the image data of said selected file format from said server.

As the Examiner admitted in the rejection filed on November 17, 2004, MURPHY does not disclose at least "a memory configured to store an e-mail address of a recipient and an address of a server corresponding to the e-mail address of the recipient" and "a transmitter configured to determine the server corresponding to the recipient when the e-mail address of the recipient is input, to transmit to said server the data in each of the predetermined plurality of file formats and to transmit to said recipient, by e-mail, the address of the server in which the data in the predetermined plurality of file formats corresponding to the image data is stored."

Thus, it is respectfully submitted that the features recited in Applicant's claims 19, 20, 22, 24, and 25-27 are not also disclosed in MURPHY cited by the Examiner.

P18153.A15

Further, the Examiner asserts in the above rejection that EP (0 835 011 A1) discloses the shortcomings of MURPHY. However, this is incorrect. In EP (0 835 011 A1), NETFAX 1 scans image data, converts the image data into a single format, such as a HTML format, and stores the converted format in an external storage 14 (col. 5, lines 44-53, col. 6, lines 29-37, col. 7, lines 14-33). The seventh embodiment, to which the Examiner directs attention, has the same configuration as the first embodiment except for having no external storage 14 (col. 13, lines 25-51), and the seventh embodiment also converts the image data into a single format. Thus, EP (0 835 011 A1) does not disclose at least “a transmitter configured to determine the server corresponding to the recipient when the e-mail address of the recipient is input, to transmit to said server the data in each of the predetermined plurality of file formats and to transmit to said recipient, by e-mail, the address of the server in which the data in the predetermined plurality of file formats corresponding to the image data is stored.” Thus, by using EP (0 835 011 A1), the recipient cannot access the server by using the address and select, from the server, image data that is stored in a file format corresponding to the capability of the recipient. Therefore, the present invention is clearly distinguished over EP (0 835 011 A1).

Therefore, it is respectfully submitted that the features recited in Applicant's claims 19, 20, 22, 24, and 25-27 are also not disclosed in EP (0 835 011 A1) cited by the Examiner. Further, the combinations of the pending claims are clearly distinct from combination of MURPHY and EP (0 835 011 A1), since both MURPHY and EP (0 835 011 A1) do not disclose at least a transmitter which transmits, to said server, the data in each of the predetermined plurality of file formats. Thus, It is respectfully submitted that the pending claims are submitted to be patentable over the Examiner's proposed combination.

Further, the Examiner has not set forth a proper motivation to combine MURPHY and EP (0 835 011 A1), since neither MURPHY nor EP (0 835 011 A1) discloses at least a transmitter which transmits, to said server, the data in each of the predetermined plurality of file formats.

Regarding the rejection of claims 21 and 23 under 35 U.S.C. § 103(a), as explained above, both MURPHY and EP (0 835 011 A1) do not disclose the features of the independent claims 19 and 22. Thus, since claims 21 and 23 are dependent from allowable independent claims 19 and 22, which are allowable for at least the reasons discussed above, these claims are also allowable for at least the these reasons. Further, all dependent claims recite additional features which further define the independent claims and provide additional bases for patentability.

Regarding the rejections of claims 22 and 25, the Examiner has asserted that arguments analogous to those presented for claim 19 are applicable. Applicant respectfully submits that the Examiner is incorrect. For example, claim 22 recites an extractor that selects image data that is stored in a file format corresponding to the capability of the image receiving apparatus. Claim 25 recites selecting image data that is stored in a file format corresponding to the capability of the image receiving apparatus. It is respectfully submitted that none of the references relied upon by the Examiner disclose these additional explicitly recited features of the claimed combinations. For this additional reason, Applicant respectfully submits that claims 22 and 25 are clearly patentable over the references relied upon by the Examiner.

Regarding SAFAI et al., the Examiner also admitted in the above rejection that SAFAI et al. does not disclose at least “a memory configured to store an e-mail address of a recipient

and an address of a server corresponding to the e-mail address of the recipient” and “a transmitter configured to determine the server corresponding to the recipient when the e-mail address of the recipient is input, to transmit to said server the data in each of the predetermined plurality of file formats and to transmit to said recipient, by e-mail, the address of the server in which the data in the predetermined plurality of file formats corresponding to the image data is stored.” In addition, EP (0 835 011 A1) also does not disclose at least a transmitter which transmits, to said server, the data in each of the predetermined plurality of file formats, as discussed above. Thus, by using EP (0 835 011 A1), the recipient cannot access the server by using the address and select, from the server, image data that is stored in a file format corresponding to the capability of the recipient. Therefore, the present invention is clearly distinguished over EP (0 835 011 A1).

Therefore, it is respectfully submitted that the combination of features recited in the claim 19 are clearly distinct from combination of SAFAI et al. and EP (0 835 011 A1), since both SAFAI et al. and EP (0 835 011 A1) do not disclose at least a transmitter which transmits, to said server, the data in each of the predetermined plurality of file formats. Thus, It is respectfully submitted that the pending claims are submitted to be patentable over the Examiner's proposed combination.

Further, the Examiner has not set forth a proper motivation to combine SAFAI et al. and EP (0 835 011 A1), since neither SAFAI et al. nor EP (0 835 011 A1) discloses at least a transmitter which transmits, to said server, the data in each of the predetermined plurality of file formats.

Regarding the JP Publication, the Examiner also admitted in the above rejection that the JP Publication does not disclose at least “a memory configured to store an e-mail address

of a recipient and an address of a server corresponding to the e-mail address of the recipient” and “a transmitter configured to determine the server corresponding to the recipient when the e-mail address of the recipient is input, to transmit to said server the data in each of the predetermined plurality of file formats and to transmit to said recipient, by e-mail, the address of the server in which the data in the predetermined plurality of file formats corresponding to the image data is stored.” In addition, EP (0 835 011 A1) also does not disclose at least a transmitter which transmits, to said server, the data in each of the predetermined plurality of file formats, as discussed above. Thus, by using EP (0 835 011 A1), the recipient cannot access the server by using the address and select, from the server, image data that is stored in a file format corresponding to the capability of the recipient. Therefore, the present invention is clearly distinguished over EP (0 835 011 A1).

Therefore, it is respectfully submitted that the combination of features recited in claim 19 are clearly distinct from the combination of the JP Publication and EP (0 835 011 A1), since neither the JP Publication nor EP (0 835 011 A1) discloses at least a transmitter which transmits, to said server, the data in each of the predetermined plurality of file formats. Thus, It is respectfully submitted that the pending claims are submitted to be patentable over the Examiner’s proposed combination.

Further, the Examiner has not set forth a proper motivation to combine the JP Publication and EP (0 835 011 A1), since both the JP Publication and EP (0 835 011 A1) do not disclose at least a transmitter which transmits, to said server, the data in each of the predetermined plurality of file formats.

Applicant further wishes to make of record a telephone interview conducted between Applicant's undersigned representative and Examiner Safaipour who is in charge of the present application on December 15, 2004.

Initially, Applicant's representative wishes to thank the Examiner for her cooperation in scheduling and conducting the above-noted interview. During the above-noted interview, Applicant's representative pointed out that neither of the primary references relied upon by the Examiner disclose converting image data into a predetermined plurality of file formats. The Examiner asserted that the prior art discloses this feature and directed Applicant's attention to MURPHY column 3, lines 33-38.

Applicant respectfully submits that this portion of the MURPHY document does not support the Examiner's position that the prior art discloses converting image data into a plurality of file formats. Rather, this portion of the disclosure of MURPHY indicates that the data can be any desired conventional file format. In this regard, Applicant notes that MURPHY explicitly recites "the native facsimile data is converted into electronic mail (e-mail) format in box 46". Thus, a single format, not a plurality of formats, are utilized. Thereafter, MURPHY merely gives examples of various conventional formats, anyone of which can be utilized and into which the "native facsimile data" is to be converted. The image compression JPEG, GIF and TIF are all well known and any one of them can be used in accordance with the features of the MURPHY disclosure. However, there is no logical or technical reason whatsoever for MURPHY to convert the "native facsimile data" into a plurality of different formats. Taken in the context of the MURPHY invention as a whole, it is quite clear that what MURPHY means by this disclosure is that the "native facsimile data" can be converted into a selected format, which can be selected from those listed.

Furthermore, if as the Examiner interprets MURPHY, MURPHY actually teaches conversion into a plurality of formats, then MURPHY is in effect performing significant duplicative and superfluous conversions. As is clear from the remainder of the noted paragraph, the data stream is then passed to electronic mail agent which performs store, send, user, password identification functions as necessary to interface with the selected server. Further, in box 52 the converted and formatted data stream is passed to box 54 and is then dynamically sent to the selected local agent server 20. However, nowhere in MURPHY is any use made of the plurality of file formats which the Examiner asserts are utilized therein. This is in direct and marked contrast to the present invention, where plural formats are provided so that a receiving apparatus can select a file format corresponding to the capability of the image receiving apparatus (claim 22) and extract the image data of the selected file format from the server. Thus, it is quite clear that MURPHY does not disclose the features for which the Examiner relies thereupon.

During the above-noted interview, the Examiner also discussed the SAFAI et al. reference and in this regard, directed Applicant's attention to column 14, lines 9-24. However, Applicant respectfully submits that this portion of SAFAI et al. also does not support the Examiner's position that SAFAI et al. discloses converting image data into a predetermined plurality of files formats as recited in Applicant's, e.g., claim 19. SAFAI et al. discloses that each digital photo is converted into an image file in a universal file format such as TIFF, GIF, JPEG, etc. Again, it is clear from the context that SAFAI et al. is merely giving examples of a plurality of universal file formats, any one of which can be utilized. Again, as with respect to the MURPHY reference, there is no logical reason based on the disclosure of SAFAI et al. to

P18153.A15

convert each digital photo into a plurality of formats. To do so would be duplicative and serve no apparent purpose in the device of SAFAI et al.

Moreover, the use of the term "such as" makes clear that SAFAI et al. is merely setting forth the TIFF, JIF, and JPEG formats as examples of formats and does not intend to imply or disclose that each digital photo is converted into all of these formats. Rather, SAFAI et al. discloses that each digital photo can be converted into any one of these formats as desired or as appropriate.

Accordingly, neither of the disclosures of the references relied upon by the Examiner support the Examiner's position that these primary references disclose at least a file converter that is configured to convert image data into a predetermined plurality of file formats, the data of each file format including all of the image data.

Unfortunately, Applicant's representative and the Examiner were not able to achieve an agreement during the above-noted interview but as noted above, Applicant's representative respectfully thanks the Examiner for her time and effort in preparing for the interview and for conducting the same.

As noted above, contrary to the Examiner's assertions in the outstanding Official Action, neither of the primary references relied upon disclose the combination of features recited in Applicant's invention, even when considered in combination with the various secondary reference relied upon. In particular, none of the references disclose the file converter as recited, e.g., in claim 19.

Moreover, the Examiner has not set forth a proper motivation for combining the features of the references utilized in the various rejections. In this regard, merely because two references relate to network facsimile communications does not automatically provide a

motivation for their combination. Moreover, the Examiner asserted that combining the systems provides a capability of transmitting a plurality of file formats. However, neither of the references actually say that they transmit a plurality of file formats, nor is there any reason based on the environments of either of these references, to assume that they actually do transmit a plurality of file formats.

The Examiner further asserts that the European Patent Application could be combined with MURPHY because "this addition would enhance the design". Of course, such an assertion by the Examiner without any evidence in the prior art supporting the same is applicable to any combination of references whatsoever. This is not a proper motivation required to support a rejection under 35 U.S.C. § 103. For these additional reasons, it is respectfully submitted that each of the Examiner's rejections is inappropriate and that reconsideration and withdrawal of the outstanding rejections is appropriate.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections and an indication of the allowability of all the claims pending in the present application in due course.


SUMMARY AND CONCLUSION

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has amended claims 19 and 24 and has made minor changes to claims 20, 21, 23, and 25 and submitted the claims for consideration by the Examiner. With respect to the pending claims, Applicant has pointed out the features thereof and has contrasted the features of the pending claims with the disclosures of the references. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully requests an indication of the allowability of all the claims pending in the present application in due course. Applicant has also provided a record of an Interview conducted with the Examiner.

Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
Toshihisa SAWADA



Bruce H. Bernstein
Reg. No. 29,027

William Pieprz
Reg. No. 33,630

February 17, 2005
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191